

REMARKS

In his Office Action dated October 24, 2003, Examiner Robert reviewed and made final his opinion that the originally-filed claims in this case could not be considered together in this application. Examiner Robert acknowledged the election with traverse of claims 35-39, and noted that claim 35 was generic. After making objections to drawings and specification, Examiner Robert initially rejected claims 35-39 on the basis of double patenting, and over identified prior art.

Applicants respectfully traverse once again the Examiner's position that all claims originally presented cannot be considered in this application. The Examiner's acknowledgement that claim 35 is generic is an indication that if claim 35 is allowable, the Examiner should allow all claims dependent on it and an additional number of species claims. Examiner Robert is respectfully requested to reconsider his position as to the originally-filed claims, and to consider them in this application, for the reasons presented in Applicants' response to his request for election, and further in light of his finding that claim 35 is generic.

Turning now to the specific objections and rejections in the Office Action, Examiner Robert first objected to the drawings "because Figure 3a is not shown in the drawings as set forth in applicant's specification page 5, lines 20 and 21." Applicants acknowledge typographical errors in those lines of the specification. He then pointed out several typographical errors concerning the references to drawings in the specification. Applicants appreciate the Examiner's thoroughness in discovering those errors. As noted above, those errors have been corrected.

Examiner Robert rejected claims 36 and 37 under 35 U.S.C. § 112, paragraph 2, on the basis that there was no antecedent basis for the term "longitudinal member." As noted above,

claims 36 and 37 have been amended to use the term “base member” rather than “longitudinal member,” as the former term is used in independent claim 35. By that amendment, Applicants have not narrowed the scope of either of claims 36 or 37. First, it is believed that “base member” is of the same or broader scope as the term “longitudinal member.” Further, claim 36 as filed referred to the “aperture” of the “longitudinal member,” and since only the “base member” in claim 35 was associated with the term “aperture,” it is clear that “longitudinal member” in claim 35 was to refer to the “base member” in claim 35. Thus, the scope of the term “base member” is at least the same as or broader than “longitudinal member,” and the use of “longitudinal member” was designed to refer to the “base member” of claim 35.

Examiner Robert then rejected claims 35-39 on the basis of judicially-created double patenting over two patents and a pending application. Applicants do not admit the propriety of the Examiner’s rejection on this ground. Nevertheless, to obviate this ground of rejection, a proper terminal disclaimer is filed herewith.

Examiner Robert took the position that claim 35 was anticipated by the Lin reference, U.S. Patent No. 5,582,612. Applicants respectfully note that the Lin reference does not show all elements of claim 35. For example, it does not show the claimed stabilizer. The Examiner maintained that the “height adjusting washer 610” of the Lin reference (see column 3, lines 64-65) is the claimed stabilizer. However, there is no disclosure in the Lin reference of the height adjusting washer providing any stability to any part of the Lin implant. On the contrary, the Lin reference suggests only that its washer affects the distance between implant part 150 and a bone. In fact, the Lin reference shows a thick, convex washer 620 that apparently fits in slot 152 (see FIG. 3a and column 4, lines 7-9). That washer will exert forces on the sides of slot 152, tending to force them apart into one example of instability. Height adjusting washer 610 cannot counter

that effect. Further, the Lin reference does not clearly show that its height adjusting washer 610 is adjacent the implant part 150. For at least these reasons the Lin reference does not anticipate claim 35.

Examiner Robert also rejected claim 38, considering it obvious over the Lin reference in view of the Devlin reference, U.S. Patent No. 3,742,583. As discussed above, claim 35 (from which claim 38 depends) is not anticipated by the Lin reference, and the Devlin reference does not include the features of claim 35 missing from the Lin reference. Accordingly, combining these references cannot show all elements of either claim 35 or claim 38. Furthermore, the Lin and Devlin references cannot be combined because they are non-analogous and because combining them would require improper hindsight.

To ensure that hindsight is not present, there must be some reason to combine evident from the references. The Lin reference does not suggest any reason for wanting to control the amount of torque applied to its nut 650. In fact, the greater the torque, the better the grip the knurled washers 630, 640 (see column 3, lines 66-67) of the Lin implant would have on other implant parts. Limiting torque would thus appear conflict with the disclosure of knurled washers in the Lin reference. Similarly, the Devlin reference does not suggest any basis for using its disclosed structure with the Lin device. The Devlin device was created specifically for a special kind of joint, one that has a sealing agent between or among parts of a joint. See, e.g., column 1, lines 6-25. The device allows a first tightening, flowing of the sealing agent and settling of the joint, and a further tightening. See column 1, line 63 to column 2, line 13. There is no sealing agent between parts of the Lin device, and the Lin reference does not give any other reason to have two separate tightenings of a nut. Thus, there is no basis in either reference to combine

them. The only possible motivation to combine them must come from the present application, which further shows impermissible hindsight.

Additionally, a reference cannot be used to create a prima-facie case of obviousness if it is “non-analogous.” “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992); MPEP 2141.01(a). It is clear that the Devlin reference is not in the orthopedic field, as is the present application. The Devlin reference is also not pertinent to the problems solved by Applicants’ invention. As explained above, the Devlin reference concerns a particular device for ensuring a sealed joint. There are no joints in Applicants’ disclosure that require a seal. Indeed, placing a seal between parts of the embodiments disclosed in the present application would increase the size of the implant and complicate it with an additional piece. Increased size and additional pieces are generally disfavored in surgical implants due to the potential for increased discomfort or errors.

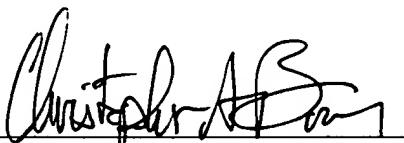
Consequently, Applicants respectfully request that the pending claims be reconsidered and the pending rejections of claims 35 and 38 over the Lin and Devlin references be withdrawn. The cited references cannot legitimately be combined against the present application, and they do not show all elements of the pending claims.

New claims 69-78 have been added with this amendment. These claims are also allowable over the references of record in this application, and were not filed to overcome any reference. Support for these claims is found throughout the specification. Further, independent claims 69 and 74 are also generic with respect to the embodiments shown in the specification.

Allowability of claims 69 and 74 will support allowance of some or all of the withdrawn claims, just as allowance of claim 35 will.

In summary, it is respectfully requested that this case be reconsidered based on the amendments and arguments offered above, and that claims 35-39, 69-78, and most or all of the claims previously withdrawn by the Examiner be allowed. The Examiner is invited to telephone the undersigned attorney at the number below if there are any questions or further issues concerning this application or amendment.

Respectfully submitted,

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